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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,646	02/09/2001	Hubert Dorn	Beiersdorf 9265.5-KGB	1049

7590 03/27/2003

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EXAMINER

LEVY, NEIL S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Examiner

Applicant(s)

Group Art. Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/10/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 10-15 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 10-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 13
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Receipt is acknowledged of RCE, Response, and IDS 3/10/03. However, no reference was provided.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for some specific compounds, does not reasonably provide enablement for The claimed formulae II or III, generally. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Not all are capable of meeting the "~~non~~ systemic" criteria, and still meeting efficacy for "control". Only specific compounds are shown to be able to be applied at effective doses to "control" cat fleas on dogs, without systemic effects via the host (we do not know if the fleas are systemically affected, since death is not a claimed feature, and control can constitute repelling; a non systemic effect. Applicant's data of the 15th of February declaration, received 6/1/01, show systemic effects of Imidacloprid, applicants exemplified compound page 10, trials C, oral, show 5 to 33% effective control with oral application –spot-on resulted in 91-100%. We have no blood work – so it is impossible to determined the contribution of systemic – trans dermal, flea blood sucking effects of Imidacloprid, and also the systemic effects to the flea from topical application. Only

chlothiandin showed no host systemic effects. We also note example 4 p. 42 uses DMSO, a permeation enhancing carrier.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0285985 or EP 0259738.

The rejection of record is maintained; applicant's arguments that the prior art is not aware of non-systemic effects, not with standing. The application, topically is the same here and in the cited art while there may be no systemic effects, even if, for prior art, unknown, there may also be systemic effects, even if unknown by applicant. The steps of the method's are the same, recitation of an negative effect an unpatentable consideration, as applicant does nothing in the steps to effect this non-effect does what the instant invention does, and does as the instant claim does, which, as shown in the instant February declaration (see above) provides systemic effects. See also the partial translation: pour on, spot on, collars etc. –

No claim is allowed.

NO claim amendment was submitted, and the date, while precluding some cumulative art (DE019519007), does not preclude the references of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

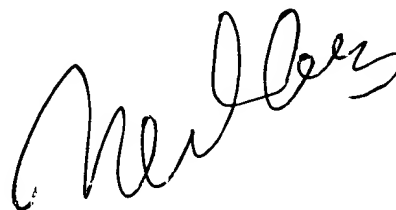
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy/LR
March 24, 2003

A handwritten signature in black ink, appearing to read "Neil S. Levy", is written in a cursive style.

NEIL S. LEVY
PRIMARY EXAMINER

NEIL S. LEVY
PRIMARY EXAMINER